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09/444,120 11/19/99 SHIODA

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EXAMINER

QM12/0208

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ART UNIT PAPER NUMBER

3711

DATE MAILED:

02/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|-----------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/444,120 | SHIODA, YOSHIHIKO |
| | Examiner Gary B. Solomon | Art Unit 3711 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 November 1999.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) Interview Summary (PTO-413) Paper No(s). _____.
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____.

DETAILED ACTION

1. The information disclosure statement submitted on Nov. 19, 1999 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement was considered by the examiner.

Objection to the Claim (37 CFR 1.75(c))

2. Claim 27 is objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 27 duplicates the subject matter of claim 24. Applicant is required to cancel the claim or amend the claim in proper dependent form, or rewrite the claims in independent form.

Rejections under 35 USC s 112, Second Paragraph

3. The following is a quotation from 35 U.S.C. s 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 and 24-28 are rejected under 35 U.S.C. s 112, second paragraph as being indefinite as failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

In claim 1, the terms "approaching the size of or greater than " (line 8) and "approaching that of or exceeding that of" (line 10-11) has no clear meaning. The above examples are sample 112 errors. Correction is required for all claims

containing 35 U.S.C. s 112 errors. Claims 1-22 are rejected as they depend on claim 1.

Claim Rejections under 35 USC § 102(b)/103(a)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made,

7. Claims 24, 25, and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Henderson.

Henderson, as discussed previously, teaches the use of a golf ball 21 secured to an anchoring stake 6 by a tether (col. 2, line 112) for use in practice.

Referring to claims 24, 25, and 27, in view of the 112 problems, discuss above, the golffball of Henderson is considered substantially the same as a baseball/softball: both are hard, round, approximately the same size, and both are hit by a club.

Claim Rejections under 35 USC s 103(a)

8. Claim 1, 2, and 18-21, as understood, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McLaughlin.

McLaughlin is an improved golf practice set consisting of a metal standard or upright A fixed to a base B by means of a socket C. A horizontal arm G projects outward from the standard . Pivotably suspended upon the pin H at the end of the horizontal arm G is rod J. A golf ball is suspended from the rod J by means of a cord M which is attached to rod J by means of a ring N.

In view of the 112 problems, above, McLaughlin is considered to disclose an object "approximately" the size of a baseball.

Claim 2 recites a ball: "... said object is ... the same as a softball". A golfball is considered substantially the same as a baseball/softball; they are hard, round, approximately the same size, and both are hit by a club.

With reference to claims 19 and 20, McLaughlin does not show the height of the arm above the floor or base. It would have been obvious to a skilled artisan in the art of practicing club or bat impact sports to keep the object suspended at various heights to insure the player does not impact the horizontal bar assembly with his club when practicing.

9. Claims 3-6 are rejected under 35 U.S.C. s 103(a) as unpatentable over McLaughlin in view of Morgan and Wallace.

McLaughlin , as discussed above, teaches a golf practice set consisting of a base, upright, and horizontal arm from which a golf ball is suspended.

Wallace teaches a tethered ball adaptable to a variety of different games which require different constructions, weights, dimensions and/or flight characteristics (col. 2, lines 38-42).

Morgan teaches a safety ball to be used to substitute for a baseball and softball. Morgan lists the weights and diameters of both in Table I and 2.

It is considered obvious to substitute tethered balls of various weights and dimensions as taught in Wallace and Morgan into the practice golf set of McLaughlin in order for the device to be used for practicing a wide variety of different games or sports instead of limiting its usage to one type of game.

10 Claims 7 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin in view of Morgan and Wallace as applied to claim 1 above, and further in view of Kuo.

McLaughlin teaches a golf practice set comprised of base, standard and horizontal bar from which is suspended a golf ball.

Wallace teaches a tethered ball which can be of a variety of configurations to enable its use in a variety of sports.

Morgan contains the approximate dimensions of a baseball and softball.

Kuo, in its Figure 1, indicates that a punching bag has been known to consist of a sack or bag suspended from its folds gathered at one end and encircled by a rope.

It is considered obvious to substitute the punching bag shown in Kuo, which is substantially in the shape of a teardrop, into the practice frame and tethered ball of McLaughlin and Wallace since there is nothing in applicant's disclosure which

indicates the criticality of using any particular ball or shape or that the punching bag of Kuo would not serve the same purposes.

For the limitations regarding size and weight of claims 8-10, see above.

11. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin in view of Morgan and Wallace as applied to claims 1, 11, 13, and 16, and further in view of Paccini.

McLaughlin teaches a golf club practice device consisting of a bracket shaped frame with a golf ball suspended therefrom.

Wallace teaches a tethered ball whose weight and configuration may be varied so as to allow it to be used in a variety of sports.

Morgan describes the weights and dimensions of various baseballs and softballs.

Paccini teaches a cylindrical striking bag suitable for striking with a bat to develop muscle tone.

It would have been obvious to an artisan skilled in the art of practicing club or bat impact sports to select a scaled down version of Paccini and substitute into McLaughlin's frame in light of the teachings of the secondary references in order to vary the object to be hit making the practice device more challenging.

As stated in Paccini, the bag may be 10 inches in diameter and have a height of 20 inches with a weight of 20 pounds (col.1 lines 60-62). The weight may vary depending upon whether the bag is used by a child or an adult (col. 3, lines 56-58).

It is considered obvious that an artisan skilled in the art of impact practice sports would select suitable dimensions such as the dimensions in Paccini since there is

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nothing in the disclosure indicating the criticality of any of the dimensions or that approximate measurements would not serve the same purposes.

12. Claims 22-23 are rejected under 35 U.S.C. s 103(a) as being unpatentable over McLaughlin in view of Wallace and further in view of Critelli.

Wallace teaches a tethered ball adaptable to a variety of different games which require different constructions, weights, dimensions and/or flight characteristics (col. 2, lines 38-42).

Critelli discloses a "small" punching bag (Figure 3) with top and bottom straps 67 and 69 to restrain the bag's movement when impacted. Strap 69 is used to restrain the ball or object to the base of floor.

It would have been obvious to an artisan skilled in the art of providing practice club or bat impact sports equipment to not only use alternative objects that are secured by a tether but also to include a base restraining device as shown by Critelli in order to provide an additional anchoring means preventing disengagement of the object from the support.

13. Claims 26 and 28, are rejected under 35 U.S.C. s 103 as unpatentable over Henderson as applied to claim 24 above and further in view of Morgan and Wallace.

Henderson, discussed above, does not show a wide variety of objects that can be used as a ball.

Wallace, as discussed above is directed to a tethered ball, which can be of various weights or configurations for use in a wide variety of sports. It does not show an anchoring stake.

Morgan recites the dimensions of a softball and baseball similar to the claimed dimensions.

It is considered obvious to an artisan skilled in the art at the time the invention was made to have employed any sport ball into the ball practice assembly of Henderson to provide a greater number of usages for the device of Henderson.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clements and Spear are cited to show state-of-the-art tethered ball practice hitting aids. Craig and Miles are cited to show various types of tethered balls.

15. Any inquiry as to this communication or any earlier communication should be directed to Gary Solomon whose telephone number is (703) 605-1234. If you are unsuccessful in your attempts to reach the examiner, you should contact the Supervisory Examiner, Jeanette Chapman at (703) 308-1310.



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